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IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No. 190

CHARLES F. RUBSAM,

Petitioner

vs.

HARLEY C. LONEY COMPANY,

Respondent

PETITIONER'S BRIEF FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

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CITATION

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STATEMENT OF GROUNDS

Petitioner, on page 10 top of his Petition for a Writ of Certiorari, referred to the decision in Motor Wheel Corporation vs. Rubsam Corporation, 92 F. 2d 129 (6th Cir.), quoting:

"The interpretation of a patent is a question of law for the Court":

"In a royalty case the contract is limited by the scope of the patents, and the Court must construe them."

This case was decided June 28, 1937 by Judges Hicks, Simons and Allen, and Circuit Judge ALLEN wrote the opinion, stating at the outset that the case involves an Appeal in an action for royalties due under a patent license contract. The present case, Charles F.

Rubsam vs. Harley C. Loney Co., is identical with the former case and was decided on December 20, 1954 in the same Sixth Circuit by Judges Martin, McAllister and Miller. Two identical cases were thus involved in the same Court of Appeals for the Sixth Circuit, and two diametrically opposite decisions were rendered by two different groups of Judges.

Under Rule 19 of this High Court Petitioner could not invoke Paragraph (b) of said Rule because it states that a review on writ of certiorari will be considered only *where a Court of Appeals has rendered a decision in conflict with the decision of another Court of Appeals on the same matter.*

When two different groups of Judges render an opinion in the same Court of Appeals and one decision is in conflict with the other on the same matter, a petitioner should be permitted to invoke a rule which provides that a review on writ of certiorari will be considered where conflicting decisions have been rendered *in the same Court of Appeals.* Petitioner therefore prays that Rule 19 (b) be clarified accordingly and that he receive the benefit of its clarification for the present petition for rehearing.

In the present action for royalties due under a patent license contract, it was mandatory for the District Court and for the Court of Appeals for the Sixth Circuit to follow Judge Allen's ruling. Thus, both courts were bound to rule that the scope of the DuSang patent No. 2,029,561 terminated on July 23, 1947 when the invention of the cast-on type of weight was disclaimed. The inven-

tion became public property after the disclaimer was recorded in the Official Gazette of the United States Patent Office on August 26, 1947.

Thus, the contract, Def. Ex. 1, became ineffective because it was based on the validity of the DuSang patent. It is noteworthy to quote here the explanation given to this Court in Respondent's reply brief on page 6 bottom and page 7 top as follows:

On February 17, 1936, when Rubsam and Hume signed Pl. Ex. A, DuSang certainly owned the exclusive rights to make the cast-on form of weight. He had obtained this in the contract of December 12, 1934 (Def. Ex. 1, R. 21). As to that form of weight, Hume and Respondent were powerless to grant rights to Rubsam. Therefore no rights were granted to Rubsam to the cast-on weight, by Paragraph 2 of Pl. Ex. A (R. 4). All rights to the cast-on weight were specifically excepted by the language which mentions the earlier Hume-DuSang contract (Def. Ex. 1, R. 21).

This statement by Respondent, who knew of the DuSang disclaimer*, was completely untrue because all

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*The Disclaimer as it appears on page 3 of the DuSang Patent No. 2,029,561, Plf' Ex. E-1, reads as follows:

DISCLAIMER

2,029,561.—*Virgil L. DuSang*, Kokomo, Ind. WHEEL BALANCING WEIGHT. Patent dated Feb. 4, 1936. Disclaimer filed July 23, 1947, by the assignee, *Turner Manufacturing Company*. Hereby disclaims claim 1 of said patent.

[*Official Gazette August 26, 1947.*]

rights to the cast-on weight had become public property after July 23, 1947. From then on, Respondent still owed royalty *on the spring clip weight* under the remaining patents owned and controlled by Respondent as Petitioner explained it in the Statement of his original petition on page 3. Petitioner therefore prays that this Court reconsider its order of denial on the basis of Judge Allen's ruling in *Motor Wheel Corporation vs. Rubsam Corporation.*

Petitioner certifies that this petition is restricted to the grounds above specified, is presented in good faith and not for the purpose of delay.

CONCLUSION

Respondent's "Statement of the Case" is contradicted by the evidence as outlined in Petitioner's Conclusion on page 15 of his original petition and Petitioner prays for the Relief as stated in said Conclusion.

November 1955

Respectfully submitted,

CHARLES F. RUBSAM
Pro Se

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AUTHORITIES

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IN THE

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SUPPLEMENTAL ARGUMENT IN SUPPORT OF PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI

TO THE CHIEF JUSTICE AND MEMBERS OF THE SUPREME COURT OF THE UNITED STATES:

STATEMENT OF GROUNDS

This is a contract action based upon certain patent license agreements granting exclusive rights to the Petitioner, Charles F. Rubsam, upon five patents owned by Respondent. Petitioner sought injunctive relief against invasion of his exclusive rights, an accounting for unpaid royalties, and assessment of costs.

The scope and validity of all the patents was directly involved. Nevertheless the courts below ruled against Petitioner upon the assumption that the DuSang patent was valid.

Prior to the decisions below the DuSang patent had been held invalid in the Seventh Circuit, and a disclaimer had been made, thus making it public property under the United States Patent Law.

The decisions below did not construe the scope of the patents nor their validity, which is essential in determining the rights under patent license contracts which are limited by the scope of the patents.

The decisions below were based upon the interpretation of the license agreement in connection with one patent, but no determination was made in connection with the remaining patents upon which the original proceeding was based.

The DuSang patent covered the cast-on form of weight, while the remaining patents covered the spring clip weights. Thus, even though the DuSang patent were still in effect and valid, nevertheless the Petitioner would still be entitled to royalties under the remaining patents. The decisions below did not preserve Petitioner's rights in connection with these latter patents. In other words, it is just as vital to rule not only on the limited scope of an invalid patent, but also on the full scope of the remaining valid patents upon which the patent license contract was based.

This same proposition and principle was involved in the case of Motor Wheel Corporation vs. Rubsam Corporation, 92 F. 2nd, 129 (6th Cir.) where the court stated at page 131:

"In a royalty case the contract is limited by the scope of the patents, and the court must construe them. Cf. Western Electric Co. v. Robertson, 142 F. 471 (C.C.A.2); General Motors Corporation v. Swan Carburetor Co., 88 F. (2nd) 876 (C.C.A.6). Here the court ruled upon the scope of the patents."

ARGUMENT

A rehearing should be granted in order to determine the effect and scope of the invalidity of the DuSang patent on the patent license contract, so far as the cast-on wheel balancing weights were concerned; and for further purpose of determining the full scope of the several valid remaining patents for which royalties are due Petitioner, so far as the spring clip wheel balancing weights were concerned.

A rehearing likewise should be granted for the purpose of resolving a conflict in the application of the above patent law principles in the same Circuit wherein diametrically opposite decisions were rendered in connection with Petitioner's patent license royalty contracts.

CONCLUSION

The petition for rehearing should be granted and is based on Rule 58 of Revised Rules of the Supreme Court of the United States, and upon the principle laid down in the case of Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47, 50.

CERTIFICATE

I, PERCY C. HECKENDORF, certify that the Supplemental Argument in Support of Petition for Writ of Certiorari is based upon Rule 58 of the Revised Rules of the Supreme Court of the United States and is presented in good faith and not for delay, and is restricted to the grounds set forth in paragraph 2 of said Rule and the principle in the case of Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47, 50.

PERCY C. HECKENDORF
Attorney for Petitioner